THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. COTROPIA

Appeal No. 97-0477
Application 07/396,751[1]

ON BRIEF

Before WINTERS, WILLIAM F. SMITH and METZ, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

ON REHEARING

On January 9, 1998, appellant filed a request for rehearing from our original decision mailed December 10, 1997. In that decision, we affirmed a double patenting rejection of claims 49, 54, 61, 68, 93, 98 and 99. We also affirmed the rejection of claims 40, 49 through 54, 61, 63 through 68, 77,

[1] Application for patent filed August 24, 1989.

78, 90, 91 and 93 through 99 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure. We reversed other rejections in the case, and we entered a new ground of rejection of claim 40 under 35 U.S.C. § 112, second and fourth paragraphs.

The request for rehearing is not a model of clarity, and does not refer to any claim or claims in the application. However, as best understood, the request does not argue that we overlooked or misapprehended any point of law or fact in affirming the double patenting rejection of claims 49, 54, 61, 68, 93, 98 and 99. Nor does it appear that appellant requests rehearing of our decision affirming the rejection of claim 40 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure. Nor does appellant take issue with the new ground of rejection of claim 40 under 35 U.S.C. § 112, second and fourth paragraphs. Rather, it appears that appellant requests rehearing only to the extent that we affirmed the rejection of claims 49 through 54, 61, 63 through 68, 77, 78, 90, 91 and 93 through 99 under 35 U.S.C. § 112, first paragraph, as based on a non-enabling disclosure.

According to appellant,

> the scientific articles published before the application filing date and set forth in the Applicant's Brief on Appeal (filed herein on June 6, 1994), at pages 12-17, were overlooked by the Board in reaching its decision. [Request for Reconsideration, page 2, third paragraph].

Manifestly, the above-quoted argument is incorrect. See our original opinion, page 9, last paragraph, making it clear that we reviewed the scientific articles set forth in the Appeal Brief, pages 12 through 17, in reaching our decision.

In our original opinion, we evaluated and weighed the specification evidence relating to preparation of a SIP (Example 12) and the CDR technique outlined in the Appeal Brief. As stated in our opinion, page 10, "we place more weight on Example 12" and "the CDR technique should be given less weight because that technique is entirely outside the description set forth in the specification." In the request for rehearing, appellant does not take issue with the manner in which we evaluated and weighed evidence. Appellant does not present any rationale explaining why we erred in placing more weight on Example 12 and less weight on the CDR technique.

In our original opinion, page 11, we discussed the publication by Levi et al. describing how workers obtained a

SIP which neutralizes HIV-1 in vitro. That publication is dated May 1993, compared with the August 24, 1989 filing date of this application. As we stated in our original opinion, "[o]n this record . . . appellant has not established that Levi et al.'s successful results were the product of routine experimentation based solely on pre-filing date technology and knowledge." In the request for rehearing, appellant does not take issue with that statement or explain why it is incorrect. Again, appellant has not established that Levi et al.'s successful results were the product of routine experimentation based solely on pre-filing date technology and knowledge, e.g., the scientific articles discussed in the Appeal Brief, pages 12-17, and listed in the request for rehearing, page 3.

We have considered appellant's request to the extent indicated above, but we decline to modify our original decision in any manner.

The request is denied.

No time period for taking any subsequent action in connec-tion with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

SHERMAN D. WINTERS Administrative Patent Judge	)
WILLIAM F. SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
ANDREW H. METZ Administrative Patent Judge	)

Richards, Harris, Medlock & Andrews
4500 Renaissance Tower
1201 Elm St.
Dallas, TX 75270-2197